

## **REMARKS**

### **Status of the Claims**

Claims 5-6, 8, 14-16, 18-23, 25-26, 29, and 31 are currently amended and Claim 30 is cancelled herein. Claims 1, 17, 24, and 27-28 were previously cancelled. Therefore with this amendment, Claims 2-16, 18-23, 25-26, 29, and 31 are currently pending and under examination.

Support for the amendment to Claims 26 and 29 is found in the Specification at least at page 3, 2<sup>nd</sup> full paragraph; page 10, first full paragraph; Fig. 1; and pending Claim 26 of the present application (translation document pages). Therefore, the amendment does not introduce new matter into this application. Applicants further maintain that the amendment does not narrow the scope of these claims, but rather clarifies. The subject matter of Claim 30 appears in Claims 6, 26, and 29, therefore Claim 30 is cancelled herein.

The remaining amendments to Claims 5-6, 8, 14-16, 18-23, 25-26, 29, and 31 are made to address various clerical issues, therefore these amendments do not introduce new matter or alter the scope of these claims.

### **Rejection Under 35 U.S.C. § 103(a)**

Claims 2-16, 18-23, 25-26, and 29-31 were rejected by the Patent and Trademark Office (“PTO”) under 35 U.S.C. § 103(a) as being obvious over JP 07-011755 to Tajima (“*Tajima*”) in view of U.S. Patent No. 5,932,337 to Edinger et al. (“*Edinger*”).

Referring to Drawing 5 and paragraph [0013] of *Tajima*, the PTO states that *Tajima* discloses “...a second layer having a nonwoven fabric reinforcement embedded in a synthetic resin such as PVC” [emphasis added, Office Action Section 3 (p. 2), lines 4-6]. The PTO further asserts that the nonwoven fabric of *Tajima* functions as a reinforcing component [Section 3 (p. 2), line 7], and teaches forming a reinforcing layer and combining it with a carrier layer [Section 3 (p. 3), lines 13-14]. The PTO appears to conclude that this

disclosure provides motivation to combine the teachings of *Tajima* and *Edinger*, and such combination renders obvious Applicants' claimed invention. Applicants respectfully traverse this rejection for at least the following reasons.

**1. *Tajima* is completely silent with respect to a reinforcing component and therefore does not support the proposition relied upon by the PTO.**

*Tajima* is drawn to a flooring "which can express the pattern of a carpet design...." (paragraph [0003]) prepared by "fixing coloured fibre in the synthetic resin..." (Abstract). Thus, *Tajima*'s fabric is used solely for decorative purposes. Applicants can find no reference in *Tajima* to use of a fabric for reinforcing purposes. Accordingly, PTO's proposition that *Tajima* discloses a fabric that functions as a reinforcing component is entirely unsupported by this reference, because *Tajima* is completely silent with respect to any reinforcement material.

Respectfully, Applicants maintain that *Tajima* does not support this proposition for which the PTO cites this reference. The Federal Circuit has required that in holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.<sup>1</sup> Accordingly, Applicants maintain that there is no suggestion or motivation found in either *Tajima* or *Edinger* to combine these references, and therefore a *prima facie* case of obviousness has not been made.

**2. *Tajima* does not disclose fabric embedded in a synthetic resin and therefore does not support the proposition relied upon by the PTO.**

Contrary to the PTO's assertion, *Tajima* does not disclose a nonwoven fabric material reinforcement embedded in a synthetic resin. Rather, *Tajima* merely states that a "...synthetic resin is impregnated into a coloured fibre aggregate comprising a nonwoven fabric" (emphasis added, Abstract, lines 4-6). *See also*: "impregnation" in *Tajima* paragraph

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<sup>1</sup> See *Karsten Mfg. Corp. v. Cleveland Gulf Co.*, 242 F.3d 1376, 1385, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001).

[0013]. Consistent with this characterization, Drawing 5 reveals that the thickness of surface layer **21** is **equal to** the thickness of the nonwoven fabric **31**, because the synthetic resin **33** is **impregnated into** the nonwoven fabric **31**.

In sharp contrast, the reinforcement material of Applicants claimed invention, as illustrated in FIG. 1, is **substantially completely surrounded** by a coating compound so that a **closed layer** is formed around the reinforcement material. *Tajima* does not disclose a reinforcement material that is substantially completely surrounded by a coating compound.

Respectfully, Applicants maintain that *Tajima* does not support the proposition for which the PTO cites this reference. Accordingly, Applicants maintain that there is no suggestion or motivation found in either *Tajima* or *Edinger* to combine these references, and therefore a *prima facie* case of obviousness has not been made.

**3. Even the improper combination of *Tajima* and *Edinger* does not teach or suggest every element of claimed invention.**

Even if *Tajima* and *Edinger* could properly be combined, a statement with which Applicants strongly disagree, such a combination does not teach or suggest every element of claimed invention. At best, this combination of references would require a synthetic resin **impregnated into** a fabric, such that the thickness of surface layer would be equal to the entire thickness of the fabric. This combination of references would also require, at best, colored fabric with no utility for reinforcing, but rather used solely for decorative purposes.

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence.<sup>2</sup> The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated one of ordinary skill in the art to modify a reference or to combine references.<sup>3</sup> Further, the prior art reference or combination of references must teach or suggest all the limitations of the claims.<sup>4</sup> Respectfully, and for at least the reasons

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<sup>2</sup> See *Burlington Indus., Inc. v. Quigg*, 822 F.2d 1581, 1584, 3 U.S.P.Q.2d 1436, 1439 (Fed. Cir. 1987).

<sup>3</sup> See *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

<sup>4</sup> See *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

provided herein, Applicants maintain that even the improper combination of *Tajima* and *Edinger* does not teach or suggest every element of claimed invention.

Respectfully, Applicants maintain that *Tajima* does not stand for the proposition for which it is cited by the PTO, and therefore no suggestion or motivation to combine these references is found. Applicants assert that *Tajima* and *Edinger*, either alone or in combination, do not support a *prima facie* case of obviousness. Even if these references could properly be combined, a statement with which Applicants strongly disagree, Applicants maintain that such combination neither teaches nor suggests Applicants' claimed invention. Accordingly, Applicants' request that the rejection of Claims 2-16, 18-23, 25-26, and 29-31 under 35 U.S.C. § 103(a) over *Tajima*, in view of *Edinger*, be withdrawn.

### **CONCLUSION**

In view of the above amendments and remarks, Applicants respectfully aver that the rejection of the claims as set forth in the Office Action has been obviated. Hence, Applicants maintain that all Claims are in condition for allowance and request that an early notice of allowance be issued.

No fees are believed due, however, the Commissioner is hereby authorized to charge any deficiencies which may be required, or credit any overpayment to Deposit Order Account No. 09-0528.

If issues may be resolved by Examiner's Amendment, or clarified in any manner, a call to the undersigned attorney at (404) 879-2435 is respectfully requested.

Respectfully submitted,



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